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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,053

11/26/2003

Jim Windheuser

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CROMPTON, SEAGER & TUFTE, LLC  
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EXAMINER

KENNEDY, SHARON E

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,053

Applicant(s)

WINDHEUSER ET AL.

Examiner

Sharon Kennedy

Art Unit

3762

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/16/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

### DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

#### ***Double Patenting***

Claims 21-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, 18-27 of U.S. Patent No. 6,096,009. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application encompass the claims of the parent.

Claims 27-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,663,597. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application encompass the claims of the parent.

It is noted that the claims are rejected under only a portion of the claims of the parent application(s), not the entire patented claims. Regarding the filing of terminal disclaimers, please read and heed the following section copied from MPEP 1490, emphasis added.

#### 1490 [R-2] Disclaimers

##### OTHER MATTERS DIRECTED TO TERMINAL DISCLAIMERS

\*>Pursuant to the last sentence of 35 U.S.C. 253, "any patentee or applicant may disclaim or dedicate to the public... any terminal part of the term, of the patent granted or to be granted". Accordingly, the disclaimer must be of a terminal portion of the term of the *entire patent* to be granted. A disclaimer of a terminal portion of the term of *an individual claim, or individual claims will not be accepted*.

***Claim Rejections - 35 USC § 102***

Claims 21-25, 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell et al., US 561,059. There is no mention of an endoscope in the patent; however, the examiner reads the claim for structure and not intended use. See figures 6, 3 and 1. Figures 3 and 6 can be interpreted to be the locking device. Claim 27 is distinguished because the locking device is attached to the endoscope and thus the endoscope is considered to be positively recited. See line 3 of claim 27. See line 3 of claim 27. Claims 35-40 are anticipated as reciting the same structure shown in figures 3 and 6, albeit the Mitchell patent has a different function.

Claims 21-25, 27-30, 34-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ferrara, US 4,995,872. Note the comments in the previous patented applications. This reference has been applied before. Note especially figure 4 of Ferrara. Regarding the releasable aspects of the Ferrara bridge, note column 9, lines 25+, which describes the use of the device. The urologist assembles the bridge to an appropriate endoscope. Regarding claim 40, the means for attachment (Ferrara 26) clearly is not encircling the entire endoscope.

***Claim Rejections - 35 USC § 103***

Claims 26, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara '872. The comments set forth in the parent applications are incorporated herein. Lengthening cytoscope bridge would result in applicant's claimed combination,

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and clearly one could put whatever they needed into the catheter 32, including a guidewire.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is 571/272-4948. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571/272-6996.

Information regarding the status of an application may be obtained by going to [www.uspto.gov](http://www.uspto.gov), clicking on "Status &IFW", entering the application number, and then clicking on one of the tabs to retrieve the appropriate information.



Sharon Kennedy  
Primary Examiner  
Art Unit 3762